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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,360	06/13/2001	Steven E. Norby	20366-080400	8741
20350	7590	06/10/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			NG, CHRISTINE Y	
			ART UNIT	PAPER NUMBER
			2663	

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,360

Applicant(s)

NORBY, STEVEN E.

Examiner

Christine Ng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-9, 11-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9, 11-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. The indicated allowability of claims 4, 10 and 19 is withdrawn in view of the newly discovered reference(s) to U.S. Patent No. 6,870,827 to Voit et al. Rejections based on the newly cited reference(s) follow.

3. Claims 1-3, 5-7, 9, 11-13, 15, 17, 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,870,827 to Voit et al.

Referring to claim 1, Voit et al disclose in Figure 3 a method for establishing a personal communication between an originating end (SSP 13/Internet module 92) and a terminating end (SSP 17/Internet module 94) of a communication system. Refer to Column 6, line 52 to Column 7, line 7. The method comprises steps of:

Retrieving (from a caller's call processing record CPR) a first plurality of personal communication modes (call routing through PSTN 10 and Internet 50) associated with the originating end. The caller's CPR holds information on whether a call should be routed though the PSTN or the Internet. Refer to Column 3, line 66 to Column 4, line 24.

Selecting one of the first plurality of personal communication modes (either call routing through PSTN 10 or Internet 50), wherein the selecting step comprises:

Determining if a second plurality of personal communication modes (call routing through PSTN 10 and Internet 50) associated with the terminating end comprises any personal communication modes compatible with the first plurality of personal communication modes. A local gateway router tests compatibility by sending a PING to a destination gateway router and determining the quality of service. Refer to Column 8, line 56 to Column 9, line 17.

Automatically choosing a compatible personal communication mode from the first plurality of personal communication modes and the second plurality of personal communication modes. If the quality of service is above a threshold specified in the CPR, the call is routed through the Internet. If the quality of service is below a threshold specified in the CPR, the call is routed through the PSTN. Refer to Column 9, lines 18-44.

Indicating the compatible personal communication mode to the terminating end. The local gateway router does the comparison of the quality of service to the threshold and initiates the call either through the PSTN or the Internet, thereby indicating the communication mode to the terminating end. Refer to Column 9, lines 18-44.

Wherein the compatible personal communication mode uses a communication transport method: voice over Internet protocol (call routing through Internet 50).

Referring to claim 2, Voit et al disclose in Figure 3 that the method further comprises the steps of:

Receiving the first plurality of personal communication modes (call routing through PSTN 10 and Internet 50) from a first user (source CPE 12) associated with the originating end (SSP 13/Internet module 92). Refer to Column 3, line 66 to Column 4, line 24 and Column 6, lines 58-64.

Receiving the second plurality of personal communication modes (call routing through PSTN 10 and Internet 50) from a second user (destination CPE 12) associated with the terminating end (SSP 17/Internet module 94). Refer to Column 3, line 66 to Column 4, line 24 and Column 6, lines 58-64.

Referring to claim 3, Voit et al disclose in Figure 3 that the compatible personal communication mode (call routing through PSTN 10 and Internet 50) couples communication between individuals (users of CPE 12). Refer to Column 6, lines 58-64.

Referring to claim 5, Voit et al disclose in Figure 3 that the first plurality of compatible personal communication modes (call routing through PSTN 10 and Internet 50) are stored in a database (CPR) that is: remote to the originating end, remote to the terminating end. The CPR database is located in the ISCP 40 that the located remote to SSP 13/Internet module 92 and SSP 17/Internet module 94. Refer to Column 6, lines 21-26.

Referring to claim 6, Voit et al disclose in Figure 3 that the automatically choosing step is based, at least in part, upon input received from: an originating end (SSP 13/ Internet module 92). The choosing is based on input from SSP 13/Internet module 92 since the source CPE 12 connected to SSP 13/Internet module 92 must first indicate that it requests an Internet connection. The request can be made through

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preselected conditions in the CPR or by dialing a special prefix service code. Refer to Column 8, lines 4-45.

Referring to claim 7, Voit et al disclose in Figure 3 a method for automatically selecting a compatible personal communication mode (either call routing through PSTN 10 or Internet 50) between an originating end (SSP 13/Internet module 92) and terminating end (SSP 17/Internet module 94) of a communication system. Refer to Column 6, line 52 to Column 7, line 7. The method comprises the steps of:

Receiving (from a caller's CPR) a first plurality of personal communication modes (call routing through PSTN 10 and Internet 50) associated with a originating end. Refer to Column 3, line 66 to Column 4, line 24.

Receiving (from a caller's CPR) a second plurality of personal communication modes (call routing through PSTN 10 and Internet 50) associated with a terminating end. Refer to Column 3, line 66 to Column 4, line 24.

Initiating a first personal communication between the originating end and terminating end. As shown in Figure 7, if a user does not request an Internet call, the call is routed by default through the PSTN. Refer to Column 9, line 65 to Column 10, line 3.

Selecting the compatible personal communication mode (either call routing through PSTN 10 or Internet 50) based upon the first plurality of personal communication modes and the second plurality of personal communication modes. Refer to the rejection of claim 1.

Initiating a second personal communication using the compatible personal communication mode. The local gateway router does the comparison of the quality of service to the threshold, and initiates the call either through the PSTN or the Internet. Refer to Column 9, lines 18-44.

Wherein the compatible personal communication mode uses a communication transport method: voice over Internet protocol (call routing through Internet 50).

Referring to claim 9, Voit et al disclose in Figure 3 that the selecting step comprises steps of negotiating the compatible personal communication mode with a first decision tree (comparing quality of service with a threshold) associated with the originating end (SSP 13/Internet module 92) and a second decision tree (comparing quality of service with a threshold) associated with the terminating end (SSP 17/Internet module 94). Refer to Column 8, line 65 to Column 9, line 17.

Referring to claim 11, refer to the rejection of claim 3.

Referring to claim 12, refer to the rejection of claim 5.

Referring to claim 13, Rune discloses in Figure 4 a personal communication system for establishing personal communication between a originating end (SSP 13/Internet module 92) and a terminating end (SSP 17/Internet module 94). Refer to Column 6, line 52 to Column 7, line 7. The personal communication system comprises:

A first plurality of personal communication modes (call routing through PSTN 10 and Internet 50) associated with the originating end. Refer to Column 3, line 66 to Column 4, line 24.

A second plurality of personal communication modes (call routing through PSTN 10 and Internet 50) associated with the terminating end. Refer to Column 3, line 66 to Column 4, line 24.

A first personal communication mode that couples the originating end and the terminating end together. As shown in Figure 7, if a user does not request an Internet call, the call is routed by default through the PSTN. Refer to Column 9, line 65 to Column 10, line 3.

A decision mechanism (quality of service compared with a threshold) for automatically choosing a second personal communication mode that is compatible with at least one of mode in each of the first plurality of personal communication modes and the second plurality of personal communication modes. Refer to the rejection of claim 1.

Wherein the compatible personal communication mode uses a communication transport method: voice over Internet protocol (call routing through Internet 50).

Referring to claim 15, Rune discloses in Figure 4 that the decision mechanism (quality of service compared with a threshold) is in the terminating end (SSP 17/Internet module 94). Internet module 94 plays a role in the decision making process since it receives and sends back the PING test. Refer to Column 8, line 65 to Column 9, line 17.

Referring to claim 17, Voit et al disclose in Figure 3 that the first plurality of personal communication modes (call routing through PSTN 10 and Internet 50) is sent from originating end (SSP 13/Internet module 92) to the terminating end (SSP 17/

Internet module 94) using the first personal communication mode. SSP 13/Internet module 92 and SSP 17/Internet module 94 transmit PING packets back and forth to determine a compatible communication mode. Refer to the rejection of claim 1.

Referring to claim 18, Rune discloses that that the second personal communication mode is different from the first personal communication mode. The second personal communication mode may be different from the first personal communication mode, if the Internet connection is chosen as the second personal communication mode. Refer to the rejection of claim 1.

Referring to claim 20, refer to the rejection of claim 5.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,870,837 to Voit et al in view of U.S. Patent No. 6,868,080 to Umansky et al.

Voit et al does not disclose the method further comprises the step of determining that a first personal communication mode for the first personal communication is unavailable (claim 8) nor that a determination is made that the first personal communication mode is unavailable before the decision mechanism chooses the second personal communication mode (claim 14).

Umansky et al disclose in Figure 1 communicating between two PSTN devices 14A and 14C using either the VOIP network 20 or the PSTN network 18. During a VOIP call, the quality of service is monitored and if it falls, the network falls back and routes the call through the PSTN network. Similarly, if the quality of service improves during the PSTN call, the call is routed back through the VOIP network 20. Refer to Column 3, lines 3-25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the step of determining that a first personal communication mode for the first personal communication is unavailable (claim 8) nor that that a determination is made that the first personal communication mode is unavailable before the decision mechanism chooses the second personal communication mode (claim 14); the motivation being that once the first personal communication mode is unavailable, a second personal communication mode can be chosen to facilitate uninterrupted communication between devices.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,870,837 to Voit et al in view of U.S. Publication No. 2002/0018487 to Chen et al.

Voit et al do not disclose a query menu presented to a user associated with the originating end, wherein presentment of the query menu is performed in response to the first communication mode being unavailable.

Chen et al discloses in Figure 2 a mobile station 205 that includes an application programming interface API 210 that allows "a programmer to change the communication protocol used by an apparatus by selecting an option in a simple menu

of options" (Section 0017) in order to "provide timely and efficient adaptation to meet the ever-changing needs of the wireless communication field" (Section 0009). Refer to Section 0040. Although Chen et al do not state that the menu is presented when the first communication mode becomes unavailable, this would allow the user to experience uninterrupted service by immediately switching to a functional mode. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a query menu presented to a user associated with the originating end, wherein presentation of the query menu is performed in response to the first communication mode being unavailable, the motivation being so that the wireless system can be more flexible and adaptable by accommodating a variety of communication protocols each with its own unique system requirements and allowing the mobile station to be used in different environments as it moves from one location to another. Refer to Sections 0003-0011.


Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Ng whose telephone number is (571) 272-3124. The examiner can normally be reached on M-F; 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

C. Ng
June 7, 2005


RICKY NGO
PRIMARY EXAMINER

6/9/05